

REMARKS

Claims 25, 37, 38, 41, and 58-61 have been amended, claims 35-36 have been canceled, and claims 25-34, 37-42, and 58-61 are pending in the present application.

Office Action of April 5, 2005

Applicant has carefully reviewed and considered the Office Action of April 5, 2005. Applicant hereby requests entry of this Response and further consideration of the present application in view of the following remarks.

In the Office Action, the restriction requirement is made final stating Applicant failed to provide specific reasons for traversing the restriction requirement. The Office Action also stated that the phrase "government sponsored" in the preamble of claims 58-61 does not add effect to the claimed structure and therefore, cannot add meaning to the claims. The Office Action rejected claim 38 under 35 U.S.C. §101 for the claimed invention being directed to a non-statutory subject matter, namely, containing limitations directed towards a person. Claims 25-27, 29-40, and 42 are rejected under 35 U.S.C. §102(e) as being unpatentable over Banyai (U.S. Patent Number 6,702,668); claims 28, 41, and 58-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Banyai in view of Heidel et al. (U.S. Patent Number 5,342,047). Applicant respectfully traverses these grounds of rejection and requests reconsideration thereof in view of the above amendments and the following remarks.

Rejection under 35 U.S.C. §101

The Office Action rejected claim 38 under 35 U.S.C. §101 for the claimed invention being directed to a non-statutory subject matter, namely, containing limitations directed towards a person.

Claim 38 has been amended to remove references towards a person. Therefore, Applicant respectfully requests that the rejection be withdrawn because grounds for this rejection has been removed.

Rejection under 35 U.S.C. §102

The Office Action rejected claims 25-27, 29-40, and 42 under 35 U.S.C. §102(e) as being unpatentable over Banyai. Applicant respectfully traverses this rejection for the following reasons.

Claim 25

The Office Action rejected claim 25 under 35 U.S.C. §102(e) as being unpatentable over Banyai. The Office Action states that electronic player stations in Banyai inherently include a controller operatively couple to the value input device comprising a processor and a memory coupled to the processor. The Office Action further states, without specifically providing any support, that the controller is programmed to perform all the functions performed by the controller of claim 25. Applicant traverses the rejection for failing to particularly point out wherein in the cited reference is disclosed the elements of the claimed invention.

37 CFR 1.104(c)(2) states that when a reference is complex the particular part relied by the Office Action must be designated as nearly as practicable. It is stated in the Office Action that the electronic player stations “inherently” include a controller that comprises a processor and a memory without providing any support for such statement. Applicant also does not discern where it is disclosed in Banyai a controller programmed to receive wager data, to receive data representing a second indicia, to replace one or more indicia of a first type, to match the indicia of the second type, and to determine a value payout as in amended claim 25.

The Office Action made references to passages in Banyai as disclosing certain elements of claim 25; however, none of these passages disclose a controller performing the functions listed in claim 25. Moreover, it is clear from some of the passages that the actions taken by the controller in amended claim 25 are done by a player in Banyai. One example of such teaching by Banyai is on a passage in column 2, lines 1-5, cited by the Office Action as disclosing a controller programmed to replaced one or more indicia of a first type with an indicia of a second type (page 3, second paragraph, lines 11-14); the passage in Banyai states “when the wild

designation is drawn *the player* may deem one of his assigned designations or number to have been drawn” (emphasis added).

Furthermore, in Banyai, the “wild” symbol is part of generated by a game terminal as part of drawings (col. 2, lines 1-5; col. 4, lines 36-39; col. 5, lines 2-5, col. 6, lines 8-11) and when a wild symbol is drawn, it substitutes or represents a symbol either selected or assigned to a player.

On the other hand, the “wild” symbol in amended claim 25 is randomly generated and replaces one of the symbols selected by the player. When a wild symbol is drawn according to amended claim 25, it substitutes or represents a symbol randomly generated by the game terminal (FIGs. 7-8; pg. 22, lines 9-14).

Additionally, Banyai does not disclose associating a random multiplier with the wager, wherein the random multiplier is independent of the game and the random multiplier affects the payout from the game. The Office Action equates variations of a payout that depends on different possible matches between randomly generated numbers and player selected numbers with changes in a payout as result of a multiplier factor. Applicant totally disagrees with the examiner's interpretation.

The multiplier factor in amended claim 25 is independent from the game and further modifies the payout value from the game. The payout value may be dependent from the game, but the multiplier factor does not.

In order to anticipate the present invention, a reference must disclose all elements of the rejected claims, MPEP §2131. In view that Banyai does not disclose at least a wild symbol replacing a user selected symbol and a controller programmed to receive wager data, to receive data representing a second indicia, to replace one or more indicia of a first type, to match the indicia of the second type, and to determine a value payout as in amended claim 25, Applicant submits that amended claim 25, as amended, is patentable over Banyai and allowance thereof is respectfully solicited.

Claims 26-27, 29-32, 34, 37-40, and 42

The Office Action rejected claims 26-27, 29-32, 34, 37-40, and 42 under 35 U.S.C. §102(e) as being unpatentable over Banyai.

Applicant submits that claims 26-27, 29-32, 34, 37-40, and 42 depend from amended claim 25 and are patentable over Banyai for at least the reasons cited above in regard to the patentability of amended claim 25. Therefore, Applicant respectfully requests that the rejections be withdrawn and claims 26-27, 29-32, 34, 37-40, and 42 be allowed.

Claim 33

The Office Action rejected claim 33 under 35 U.S.C. §102(e) as being unpatentable over Banyai. The Office Action stated that a wild symbol can be used to match any of the player-selected numbers. Applicant respectfully disagrees with the examiner's interpretation of Banyai and the application.

As stated above in the remark regarding the patentability of claim 25, Banyai does not disclose a controller programmed to replace one or more indicia of a first type with an indicia of a second type; instead, in the passage cited by the Office Action, Banyai discloses the player deeming one of his designations to have been drawn when a wild symbol is drawn (col. 2, lines 1-5). There is no disclosure of a controller replacing one indicia of one type with an indicia of another type.

On the other hand, the present invention discloses that player-selected symbol may be replaced by a randomly occurring symbol (page 22, lines 16-17), which is claimed by claim 33.

In order to anticipate the present invention, a reference must disclose all elements of the rejected claims, MPEP §2131. In view that Banyai does not disclose at least a wild symbol replacing a user selected symbol, Applicant submits that claim 33, as amended, is patentable over Banyai and allowance thereof is respectfully solicited.

Rejection under 35 U.S.C. §103

The Office Action rejected claims 28, 41, and 58-61 under 35 U.S.C. §103(a) as being unpatentable over Banyai in view of Heidel et al. Applicant respectfully traverses this rejection for the following reasons.

Claims 28 and 41

The Office Action rejected claims 28 and 41 under 35 U.S.C. §103(a) as being unpatentable over Banyai in view of Heidel et al.

Applicant submits that claims 28 and 41 depend from amended claim 25 and are patentable over Banyai and Heidel et al. for at least the reasons cited above in regard to the patentability of amended claim 25. Therefore, Applicant respectfully requests that the rejection be withdrawn and claims 28 and 41 be allowed.

Claim 58

The Office Action rejected claim 58 under 35 U.S.C. §103(a) as being unpatentable over Banyai in view of Heidel et al. The Office Action stated that Banyai teaches the invention substantially as claimed but does not teach printing tickets. The Office Action further states that Heidel et al. teaches a lottery system that includes a ticket printer.

Applicant disagrees with the examiner that Banyai discloses substantially the invention for reasons stated above in regard to the patentability of amended claim 25. Applicant submits that Banyai does not disclose at least a lottery controller programmed to replace one or more indicia of a first type with an indicia of a second type for reasons.

In order to render obvious the present invention, a reference must teach or suggest all elements of the rejected claims, MPEP §2142. In view that Banyai and Heidel et al., either individually or in combination, do not disclose at least a wild symbol replacing a user selected symbol and a controller programmed to receive wager data, to receive data representing a second indicia, to replace one or more indicia of a first type, to match the indicia of the second type, and to determine a value payout as in claim 58, Applicant submits that claim 58, as amended, is patentable over Banyai and Heidel et al. and allowance thereof is respectfully solicited.

Claim 59

The Office Action rejected claim 59 under 35 U.S.C. §103(a) as being unpatentable over Banyai in view of Heidel et al. Applicant disagrees that Banyai and

Heidel et al., either individually or in combination, disclose a multiplier that is independent from the game and further modifies the payout value from the game for reasons stated above in regarding to the patentability of claim 25.

In order to render obvious the present invention, a reference must teach or suggest all elements of the rejected claims, MPEP §2142. In view that Banyai and Heidel et al., either individually or in combination, do not disclose at least a wild symbol replacing a user selected symbol, Applicant submits that claim 59, as amended, is patentable over Banyai and Heidel et al. and allowance thereof is respectfully solicited.

Claims 60-61

The Office Action rejected claims 60-61 under 35 U.S.C. §103(a) as being unpatentable over Banyai in view of Heidel et al.

Applicant submits that claims 60-61 depend from claim 58 and are patentable over Banyai and Heidel et al. for at least the reasons cited above in regard to the patentability of claim 58. Therefore, Applicant respectfully requests that the rejections be withdrawn and claims 60-61 be allowed.

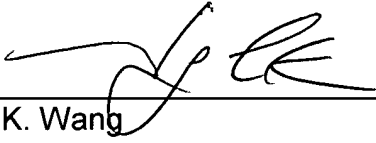
Conclusion

In view of the foregoing remarks, Applicant respectfully submits that claims 25-34, 37-42, and 58-61 are in condition for allowance and entry of the present amendment and notification to that effect is earnestly requested. If necessary, the Examiner is invited to telephone Applicant's attorney (404-815-3383) to facilitate prosecution of this application.

No additional fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, including any necessary extensions of time, which are hereby requested to Deposit Account No. 03-0683.

Respectfully submitted,
Stephen Penrice.
By his Representatives,

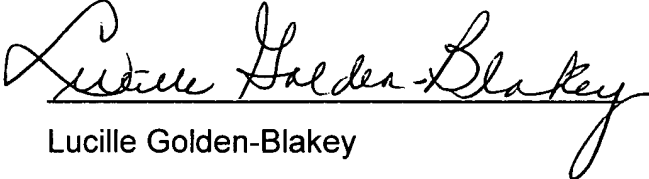
Carlton Fields
1201 West Peachtree Street, Suite 3000
Atlanta, GA 30309-3450
Telephone: 404-815-3400
Fax: 404-815-3415



Li K. Wang
Reg. No. 44,393

Date 7/12/05

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, Alexandria, VA 22313-1450, on this 12 day of July, 2005.



Lucille Golden-Blakey